



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,660	12/22/2000	Markus Pompejus	BGI-121CP2	1463

959 7590 03/26/2003

LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

EXAMINER

ZARA, JANE J

ART UNIT	PAPER NUMBER
----------	--------------

1635


DATE MAILED: 03/26/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

File

Office Action Summary

Application No. 09/746,660	Applicant(s) Pompejus et al	
Examiner Jane Zara	Art Unit 1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 31, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

File

Application/Control Number: 09/746,660

Page 2

Art Unit: 1635

DETAILED ACTION

This Office action is in response to the communication December 31, 2002, Paper No. 10.

Claims 1-47 are pending in the instant application.

Election/Restriction

The restriction election filed December 31, 2002, Paper No. 10, electing nucleic acid sequence of SEQ ID No: 1 and polypeptide sequence of SEQ ID NO: 2 has been received and entered.

SEQ ID Nos: 3-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected elections, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

Applicant's election with traverse of nucleic acid sequence of SEQ ID NO:1 and amino acid sequence of SEQ ID NO: 2 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that more than one sequence does not constitute an unreasonable number of sequences to be searched and searching up to ten sequences would pose no serious burden on the examiner. This is not found persuasive because the expansive data bases that must be searched for each SEQ ID No. claimed poses a serious burden on the search facilities and the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Pursuant to 37 C.F.R. 1.142(a), whereby the distinctness and independence of the elected inventions of the instant application have become clear upon further consideration, an examiner's

Art Unit: 1635

action on the merits insofar as they pertain to the elected invention is hereby deferred until another election has been made. (See MPEP 810.02 and 811)

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19, 23, 27, drawn to nucleic acids and host cells, classified in class 536, subclass 23.5
- II. Claims 20-22, 24-27, drawn to polypeptides, classified in class 530, subclass 350.
- III. Claims 28, 29-40, drawn to methods of producing fine chemicals, classified in class 435, subclass 487.
- IV. Claims 41-47, drawn to methods of modulating yield of a fine chemical, classified in class 435, subclasses 6 and 487.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III, IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions I, II and III, IV are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The operation and function of the compositions of Group I, comprising nucleic acids, vectors, host cells and Group II, comprising polypeptides, are completely different and distinct from the operation, function and effects of the methods of Groups III and IV, which produce fine chemicals and modulate yields of fine

Art Unit: 1635

chemicals. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the nucleic acids, vectors and host cells of Group I and the polypeptides of Group II are chemically, biologically, structurally and functionally distinct from each other and thus one does not render the other obvious. The proteins of Group II are not required to produce the nucleic acids of Group I and nucleic acids, vectors and host cells of Group I are not required to produce the polypeptides of Group II (which can be produced synthetically or isolated from cells). Therefore, the inventions of the two groups are capable of supporting separate patents.

Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions III and IV are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The methods of Groups III and IV comprise steps which are not required for or present in the methods of the other groups: producing fine chemicals (Group III) and modulating the yield of a fine chemical (Group IV). The operation, function and effects of these different methods are different and distinct from each other. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Art Unit: 1635

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

It is noted that the restriction of Groups I-IV is in addition to the restriction requirements of June 26, 2002. Upon the new election, the sequences elected in the response of December 31, 2002 will be examined to the extent that they are encompassed by the newly elected invention.

Art Unit: 1635

Conclusion

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jane Zara** whose telephone number is **(703) 306-5820**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, can be reached on (703) 308-0447. Any inquiry regarding this application should be directed to the patent analyst, Katrina Turner, whose telephone number is (703) 305-3413. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.


KAREN LACOURCIERE
PATENT EXAMINER

JZ

March 24, 2003